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EXAMINER

LAYNO, BENJAMIN

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3711

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/658,863
Filing Date: September 09, 2003
Appellant(s): YOSELOFF ET AL.

Mark A. Litman
For Appellant

EXAMINER'S ANSWER

This is in response to the Office communication filed 07/24/07.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
1-28.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." **New grounds of rejection is provided under the subheading "NEW GROUNDS OF REJECTION."**

NEW GROUND(S) OF REJECTION

Claims 1, 2, 6, 8-11, 15, 18-21 and 24-38 stand rejected under 35 USC **102(e)** as being anticipated by, or in the **alternative**, stand rejected under 35 USC **103(a)** as obvious over de Keller.

Claims 22 and 23 stand rejected under 35 USC 103(a) as being unpatentable over de Keller.

Claims 3-5, 7, 12-14, 16 and 17 stand rejected under 35 USC 103(a) as being unpatentable over de Keller and further in view of Breeding.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claims 1, 2, 6, 8-11, 15, 18-21 and 24-38 stand rejected under 35 USC **102(b)** as being anticipated by, or in the alternative, stand rejected under 35 USC 103(a) as obvious over de Keller.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,975,529	DE KELLER	11-1999
5,288,081	BREEDING	2-1994
5,685,774	WEBB	11-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 102 or § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 8-11, 15, 18-21 and 24-38 are rejected under 35 U.S.C. **102(e)** as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over de Keller.

The patent to de Keller discloses a method of playing a live casino game. At the start of de Keller's game all players place an initial multiple-part wager in Pots 8 and on Bet One 5, to participate in **a first poker game (five-card poker game)**, col. 4, lines 22-24 and col. 4, lines 31-32. Players may also optionally place a side bet wager (Bonus Bet) to participate in **a second poker-type game (three-card poker game)**, col. 5, lines 8-21. De Keller recites that at the start of the game each player is dealt a partial hand of two cards "(this number may vary)", col. 2, lines 58-63. Thus, it would have been obvious to deal a three-card partial hand to each player. De Keller also recites that "the dealer receives three cards (this number may vary) one face-up and two face-down. The three dealer's cards are community cards.....and complete each player's hand", col. 2, lines 63-66. The three community cards are inherently at least two community cards. The initial multiple-part wager is resolved according to the rules of five-card poker, which is the first poker-type game, col. 4, lines 39-44, and **a five-card poker pay-off table, col. 4, lines 53-56**. The optional side bet wager (Bonus

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Bet) is resolved according to three-card poker game, which is the second poker-type game, and a **three-card poker pay-off table, col. 5, lines 9-22**, that includes “e.g. Royal Flush, Straight Flush, etc”. **Thus, the partial hand (three-card poker hand) for the first poker-type game (five-card poker hand) is the complete hand for the second poker-type game.** The game may be played on a casino table, Fig. 1, or may be played on an electronic video wagering game, col. 5, lines 28-50. Each part of the multiple-part wager is equal, col. 2, lines 58-60.

Claim Rejections - 35 USC § 103

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Keller.

Determining exactly what odds to payout to players having winning hand combinations (e.g. 1 to 1, 20 to 1, 100 to 1, etc.), is simply a casino business decision dependent on a required house advantage and the amount of profits the casino decides to take in. This is always obvious in the art.

Claims 3-5, 7, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Keller as applied to claim 1 above, and further in view of Breeding 081’.

The patent to Breeding 081’ teaches that it is known in casino poker games for players to place a multiple-part wager 22a-22c, have three cards dealt to each player 19a-19g, have two community cards dealt 21, have the players optionally remove one

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part of their multiple-part wager after viewing their three cards, and have the players optionally remove another part of their multiple-part wager after the first community card is revealed. In view of such teaching, it would have been obvious to modify de Keller's poker game wherein each player would have been required to place a three part multiple-part wager on wagering areas 5, 6, 7 at the beginning of de Keller's game. The players' three-card partial poker hand would have been dealt, and the two community cards would have been dealt. Each player would have optionally removed one part of their multiple-part wager after viewing their three cards, and each player would have optionally removed another part of their multiple-part wager after the first community card is revealed. This modification would have provide a hedge or insurance to each player, thus preventing players from losing too much money if any player receives a losing hand in de Keller's game.

(10) Response to Argument

In regard to claim 1, the Applicant has argued that "de Keller uses five card hands **both** for a pay table event and the Pot play event. This is in contrast to claim 1 on Appeal reciting that "..., the partial hand for the first poker-type game being a complete hand for the second poker-type game;". The Applicant continues to argue that "Both games of de Keller are played with a single hand including community cards, while the claimed invention plays a first game with each player's partial hand, and only **after** receiving the community cards is the game against the pay table played. Those

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are significant and fundamental differences recited in claim 1 that establish novelty and unobviousness over the teachings of de Keller”.

Concerning claim 1, the Examiner takes the position that in de Keller second poker-type game (three-card poker hand) uses “the **first three** cards of a players hand” col. 5, line 11. These first three cards make up a partial hand, **and this partial hand has a pay table** (e.g. Royal Flush, Straight Flush, etc.), col. 5, lines 12-13 and lines 20-21. Thus, de Keller’s five-card hand is **not** used when playing the second poke-type game. Furthermore, there is **no limitation** in claim 1 of exactly when the second poker-type game is to be played. Thus, according to claim 1 the second poker-type game may be played either **before** the community cards are dealt or **after** the community cards are dealt.

In regard to claim 26, the Applicant has argued that the second wager is based upon on the partial hand cards and a ranking of the partial hand cards **ONLY**. This feature is clearly not shown by de Keller. Also the Applicant states that the claimed game is limited to play against **only** pay tables. This provides a clear avoidance of de Keller who has competition against a pay table **and** player-versus-player.

Concerning claim 26, the Examiner takes the position that de Keller recites that his disclosed game can be adapted and played on a video game machine, col. 5, line 28-49. De Keller also recites “A player, irrespective of ‘standing’ after the deal or after BET 1 will be paid a winning hand according to the number of coins bet.....The pay-offs on video styled machine like the table game, are **based on traditional poker rankings**”. The Examiner also takes the position that it is inherent and/or well known

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that players play solo on video poker machines and a player's poker hand on a video poker machine is only compared to a pay table e.g. player-versus-pay table. Thus, it would have been inherent, or alternatively obvious, for de Keller's video game machine embodiment to be a wagering game wherein players play against only pay tables. Also in de Keller's game an initial multiple part wager is placed, wherein wagers are placed on Pots 8 and on Bet One 5, col. 4, lines 21-23, prior to viewing dealt cards.

In regard to claim 18, de Keller does not teach the limitation of “**placing an optional single part wager to play a second poker-type game against a pay table using all cards in each player's partial hand**”. Again, the Examiner takes the position that in de Keller an optional single part wager (**Bonus Bet**) is placed to play a second poker-type game (three-card poker hand) which uses “the first three cards of a players hand” col. 5, line 9-11. These first three cards make up a partial hand, **and this partial hand has a pay table** (e.g. Royal Flush, Straight Flush, etc.), col. 5, lines 12-13 and lines 20-21.

Establishment Of Right To Priority Under 35 USC 120

The Applicant has also argued that the present Application establishes conceptual priority under 35 USC 120 for all limitations in the claims and antedates the available reference date of de Keller. Thus the de Keller reference (effective filing date September 11, 1995) is **not** available under 35 USC 102(b) as a reference in view of the priority date chain established for the present invention. The Applicant provided a Table comparing claim 1 of the present invention with the disclosure of the earliest application in the priority chain 08/504,023, in order to support

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for the priority date of 07/19/05. Included in the Table is a recitation in claim 1 of the present invention, “providing **community cards** to complete partial hands in the first poker-type game”. The Table indicated that this recitation is supported by the earliest application 08/504,023, which recites “According to each of these embodiments, the dealer is also preferably provided with the same number of standard cards and the **wild card** as provided to each player”. The Applicant argued that “**The single wild card to all players is a community card**”. The Examiner disagrees.

The disclosure of the present invention 10/658863 discloses the well-known game “LET IT RIDE”, which uses community cards. The community cards are used by each player to form a five-card hand, page 2, lines 14-15. The present invention also recites “In the preferred game a dealer deals three player’s cards face down to each player and two community cards face down to the dealer.....The dealer then turns over one of the dealer’s community cards and the dealer’s query is repeated.....Finally, all cards are shown and the payouts and collections are resolved....This widely played game is known as LET IT RIDE stud poker”, page 5, lines 14-26. The Examiner take the position that in LET IT RIDE, the **community cards each have a specific fixed value**, what ever value is printed on a community card, that is the value that is used by all players during game play.

The disclosure of the earliest application 08/504,023, on the other hand, **does not** disclose “community cards”. Instead, it discloses “wild cards”. Earliest application 08/504,023 recites “In a five-card game each player and the dealer may substitute the

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wild card for any other card in their hand to improve the five-card hand they hold”, col. 8, lines 50-53. Thus, **the values of “wild cards” vary according to the player’s desire.**

Thus, the disclosure of the invention in the parent application (08/504,023, which recites “wild cards” having varying values, and does not recite “community cards” having fixed values), and in the later-filed application (10/658,863 which recites “community cards” having fixed values) are **different**, and **do not comply with the requirements of the first paragraph of 35 U.S.C. 112**, and therefore the present application 10/658,863 **does not** receive the benefit of the filing date (July 19, 1995) of the parent application 08/504,023.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

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(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Benjamin H. Layno/

Benjamin Layno
Primary Examiner
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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/DONALD T HAJEC/

Director, Technology Center 3700

Conferees:

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715